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10/574,554	04/03/2006	Leonardo De Maria	10508.204-US	9304

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NOVOZYMES NORTH AMERICA, INC.  
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SUITE 1600  
NEW YORK, NY 10110

EXAMINER
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MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
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1656

NOTIFICATION DATE	DELIVERY MODE
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07/29/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,554	<b>Applicant(s)</b> DE MARIA ET AL.	
	<b>Examiner</b> WILLIAM W. MOORE	<b>Art Unit</b> 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006 and 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,9,11,13,15,16,21,24-26,28-31 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,2,4,5,7,9,11,13,15,16,21,24-26,28-31 and 37.

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. §§ 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

#### Protease Molecules and Compositions comprising same.

Group 1, claims 1, 2, 4, 5, 7, 9, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the thirteen amino acid sequence region from position 6 through position 18 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 2, claims 1, 2, 4, 7, 11, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seven amino acid sequence region from position 22 through position 28 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 3, claims 1, 2, 4, 5, 11, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eight amino acid sequence region from position 32 through position 39 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof, as well as to polynucleotides encoding same and vectors and host cells comprising such polynucleotides, and to methods of use of such polynucleotides in making the variant protease.

Group 4, claims 1, 2, 4, 5, 9, 11, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence region from position 42 through position 58 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 5, claims 1, 2, 4, 5, 9, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 62 and 63 of

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the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 6, claims 1, 2, 4, 5, 9, 11, 15, 16, 28-31, and 37, each drawn in part a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eleven amino acid sequence region from position 66 through position 76 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 7, claims 1, 2, 4, 5, 7, 9, 11, 15, 16, 28-31, and 37, each drawn in to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the twenty-three amino acid sequence region from position 78 through position 100 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 8, claims 1, 2, 4, 5, 7, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 103 through position 106 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 9, claims 1, 2, 4, 9, 11, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 111 through position 114 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 10, claims 1, 2, 4, 5, 7, 9, 11, 15, 16, 28-31, and 37, each drawn in part to, and claims drawn more particularly to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the fourteen amino acid sequence region from position 118 through position 131 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 11, claims 1, 2, 4, 5, 7, 15, 16, 28-31, and 37, each drawn in part to, and claims drawn more particularly to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 134 through position 136 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 12, claims 1, 2, 4, 5, 7, 9, 15, 16, 28-31, and 37, each drawn in part to, and claims drawn more particularly to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 139 through position 141 of the mature protease amino acid sequence of

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SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 13, claims 1, 2, 4, 5, 7, 9, 15, 16, 28-31, and 37, each drawn in part to, and claim 13 drawn more particularly to, a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eight amino acid sequence region from position 144 through position 151 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 14, claims 1, 2, 4, 5, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 155 and 156 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 15, claims 1, 2, 4, 5, 7, 9, 11, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence region from position 160 through position 176 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 16, claims 1, 2, 4, 11, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 179 through position 181 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

Group 17, claims 1, 2, 4, 7, 15, 16, 28-31, and 37, each drawn in part to a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the five amino acid sequence region from position 184 through position 188 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, to compositions comprising same and methods of use thereof.

#### Methods of Making Proteases and components thereof.

Group 18, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the thirteen amino acid sequence region from position 6 through position 18 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 19, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds

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to the seven amino acid sequence region from position 22 through position 28 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 20, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eight amino acid sequence region from position 32 through position 39 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 21, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence region from position 42 through position 58 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 22, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 62 and 63 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 23, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eleven amino acid sequence region from position 66 through position 76 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 24, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the twenty-three amino acid sequence region from position 78 through position 100 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 25, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 103 through position 106 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to

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polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 26, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 111 through position 114 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 27, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the fourteen amino acid sequence region from position 118 through position 131 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 28, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 134 through position 136 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 29, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 139 through position 141 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 30, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eight amino acid sequence region from position 144 through position 151 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 31, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 155 and 156 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

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Group 32, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence region from position 160 through position 176 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 33, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 179 through position 181 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

Group 34, claims 21-25, each drawn in part to a method of making a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the five amino acid sequence region from position 184 through position 188 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188, and to polynucleotides encoding the variant and vectors and host cells comprising such polynucleotides useful in a method of making the variant protease.

#### Transgenic Organisms.

Group 35, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the thirteen amino acid sequence region from position 6 through position 18 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 36, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to seven amino acid sequence region from position 22 through position 28 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 37, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eight amino acid sequence region from position 32 through position 39 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 38, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence

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region from position 42 through position 58 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 39, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 62 and 63 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 40, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the eleven amino acid sequence region from position 66 through position 76 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 41, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the twenty-three amino acid sequence region from position 78 through position 100 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 42, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 103 through position 106 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 43, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the four amino acid sequence region from position 111 through position 114 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 44, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to fourteen amino acid sequence region from position 118 through position 131 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 45, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 134 through position 136 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

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Group 46, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 139 through position 141 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 47, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to eight amino acid sequence region from position 144 through position 151 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 48, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the dipeptide amino acid sequence region that is positions 155 and 156 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 49, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the seventeen amino acid sequence region from position 160 through position 176 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 50, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the three amino acid sequence region from position 179 through position 181 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

Group 51, claim 26, drawn in part to a transgenic plant that comprises and expresses a polynucleotide encoding a variant of a parent protease comprising at least one amino acid substitution in a region that corresponds to the five amino acid sequence region from position 184 through position 188 of the mature protease amino acid sequence of SEQ ID NO:2 from position 1-188.

The inventions lack unity, each from the other, because of the following reasons:

According to PCT Rule 13.2 unity of invention exists only when the shared same or corresponding special technical feature is a contribution over the prior art. The inventions of Groups 1-17 do not relate to a single general inventive concept because they lack a same or corresponding special technical feature, which is defined in the claims herein in terms of a variant of a parent protease that need have no substantial degree of similarity to the reference, 188-amino acid, sequence of the mature protease of SEQ ID NO:2 where it may differ from the

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sequence of SEQ ID NO:2 at as many as 75 amino acid positions according to clause (c) of claim 1, because Sjoeholm et al., US 6,855,548<sup>1</sup> teaches at least one relative amino acid substitution at a position among the 144 amino acids within SEQ ID NO:2 recited at lines three and four of claim 1 herein in their SEQ ID NO:1, specifically, alanine rather than threonine at the position corresponding to position 87 of SEQ ID NO:2 herein, constituting a T87A substitution in the parent protease of SEQ ID NO:2 herein according to, e.g., claims 1, 2, 4, and 16 herein. As such, the first invention recited in claim 1 has no technical feature that can be considered to be a contribution over the prior art.

The inventions of Groups 1-17 and Groups 18-34 do not relate to a single general inventive concept because a product of Groups 1-17 lacks a same or corresponding special technical feature. This is because Sjoeholm et al. '548, discussed in the preceding paragraph, teach their SEQ ID NO:1 which constitutes an amino acid substitution T87A in a parent protease of SEQ ID NO:2 herein, thus each method of making a product of the Groups 18-34 lacks a special technical feature where it cannot be a method of making a first product having a technical feature that can be considered to be a contribution over the prior art.

The inventions of Groups 1-17 and Groups 35-51 do not relate to a single general inventive concept because they lack a same or corresponding special technical feature, which is defined in claim 26 as a plant transformed with a nucleic acid in order that it may express a variant of a parent protease. This is because a product of Groups 1-17 lacks a same or corresponding special technical feature where Sjoeholm et al. '548, discussed above, teach their SEQ ID NO:1 which constitutes an amino acid substitution T87A in a parent protease of SEQ ID NO:2, and because McMaster et al., US 5,877,403 teach the preparation of transgenic plants capable of expressing an exogenous protease. It would have been obvious to one of ordinary skill in the art before the invention of claim 26 was made to prepare a transgenic plant according to McMaster et al. capable of expressing an exogenous protease of SEQ ID NO:1 according to Sjoeholm et al. and as such, a plant of Groups 35-51, which inherently constitutes a component of a method of making a protease of one of Groups 1-17 that has no technical feature that can be considered to be a contribution over the prior art.

The inventions of Groups 8-34 and Groups 35-51 do not relate to a single general inventive concept because they lack a same or corresponding special technical feature. This is because each method of making a product of the Groups 18-34 lacks a special technical feature where it cannot be a method of making a first product, nor the components useful therein, that has a

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<sup>1</sup> The disclosure of US 6,855,548 is prior art under 35 U.S.C. § 102(e) in view of the 17 February 2000 filing date of the US provisional application 60/183,133 to which priority is claimed.

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technical feature that can be considered to be a contribution over the prior art, and because a product of Groups 35-51 constitutes a component of what is essentially a second method of making a product that also lacks a technical feature that can be considered to be a contribution over the prior art .

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 571.272.0933 and whose FAX number is 571.273.0933. The examiner can normally be reached Monday through Friday between 9:00AM and 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisory Primary Examiner, Andrew Wang, can be reached at 571.272.0811. The official FAX number for all communications for the organization where this application or proceeding is assigned is 571.273.8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571.272.1600.

/William W. Moore/  
Examiner, Art Unit 1656